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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/734,034 | 12/11/2003 | Munmaya K. Mishra | 00130095 | 8769 |
| 63970 7590 02/19/2008 MH2 TECHNOLOGY LAW GROUP (Cust. No. w/NewMarket) 1951 KIDWELL DRIVE SUITE 550 TYSONS CORNER, VA 22182 | | | | |
| EXAMINER | | | | |
| GOLOBY, JAMES C | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 1797 | | | | |
| MAIL DATE | | DELIVERY MODE | | |
| 02/19/2008 | | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/734,034

Applicant(s)

MISHRA ET AL.

Examiner

James Goloboy

Art Unit

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-11, 13, 15-16, 18, 20-21, 23-24, 26, 28, 30-31, 33-34, 37, 39-40, 42-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 1/30/08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continuation of Disposition of Claims: Claims pending in the application are 1-4,6-11,13,15,16,18,20,21,23,24,26,28,30,31,33,34,37,39,40 and 42-44.

DETAILED ACTION

1. Applicant's amendment filed 11/21/07 does not overcome the rejections set forth in the office action mailed 7/23/07. Further explanation of the rejections over Crawford and Samson and Crawford in view of Tokumoto necessitated by the amendment is given in paragraphs 2 and 8 below.

Claim Rejections - 35 USC § 103

2. Claims 1-4 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crawford in view of Samson.

The discussions of Crawford and Samson in the prior office actions is incorporated here by reference. Claim 1 has been amended to limit the monoalkenylarene monomer to styrene, and the styrene content of the copolymer to a range of about 30 to about 40% by weight. In the reference's claim 2, Crawford discloses a copolymer that specifically comprises 5 to 50% by weight of styrene, meeting the new limitation regarding the monoalkenylarene monomer and encompassing the newly added range. See MPEP 2144.05(I): "In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976);"

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3. Claims 1, 7, 11, 13, 15-16, and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crawford in view of Samson as applied to claims 1 and 4 above, and further in view of Papay.

This rejection is adequately set forth in paragraph 3 of the office action mailed 7/23/07.

4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Crawford in view of Papay further in view of Samson as applied to Claim 1 above, and further in view of Lundberg.

This rejection is adequately set forth in paragraph 4 of the office action mailed 7/23/07.

5. Claims 20-23, 26, 28, 30-31, 33-35, 37, 39-40, and 42-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crawford in view of Samson and Papay as applied to claims 1, 7, 11, 13, 15-16, and 18-19 above, and further in view of Lambert.

This rejection is adequately set forth in paragraph 5 of the office action mailed 7/23/07.

6. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Crawford in view of Samson, Papay, and Lambert as applied to claims 20-23 above, and further in view of Galka.

This rejection is adequately set forth in paragraph 6 of the office action mailed 7/23/07.

7. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Crawford in view of Samson, Papay, and Lambert as applied to claim 20 above, and further in view of Albertson.

This rejection is adequately set forth in paragraph 7 of the office action mailed 7/23/07.

8. Claims 1-4 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crawford in view of Tokumoto.

The discussions of Crawford and Tokumoto in the prior office actions is incorporated here by reference. Claim 1 has been amended to limit the monoalkenylarene monomer to styrene, and the styrene content of the copolymer to a range of about 30 to about 40% by weight. In the reference's claim 2, Crawford discloses a copolymer that specifically comprises 5 to 50% by weight of styrene, meeting the new limitation regarding the monoalkenylarene monomer and encompassing the newly added range. See MPEP 2144.05(I): "In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976);"

9. Claims 1, 7, 11, 13, 15-16, and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crawford in view of Tokumoto as applied to claims 1 and 4 above, and further in view of Papay.

This rejection is adequately set forth in paragraph 9 of the office action mailed 7/23/07.

10. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Crawford in view of Papay further in view of Tokumoto as applied to Claim 1 above, and further in view of Lundberg.

This rejection is adequately set forth in paragraph 10 of the office action mailed 7/23/07.

11. Claims 20-23, 26, 28, 30-31, 33-35, 37, 39-40, and 42-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crawford in view of Tokumoto and Papay as applied to claims 1, 7, 11, 13, 15-16, and 18-19 above, and further in view of Lambert.

This rejection is adequately set forth in paragraph 11 of the office action mailed 7/23/07.

12. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Crawford in view of Tokumoto, Papay, and Lambert as applied to claims 20-23 above, and further in view of Galka.

This rejection is adequately set forth in paragraph 12 of the office action mailed 7/23/07.

13. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Crawford in view of Samson, Papay, and Lambert as applied to claim 20 above, and further in view of Albertson.

This rejection is adequately set forth in paragraph 13 of the office action mailed 7/23/07.

Response to Arguments

14. Applicant's arguments have been fully considered but they are not persuasive. Applicant argues that Crawford only teaches copolymers comprising 25% styrene. However, as discussed above, Crawford more generally discloses copolymers comprising 5 to 50% styrene, encompassing the range recited in the amended claims. Applicant has not demonstrated the criticality of the claimed range.

Applicant further argues that Lambert does not teach or suggest a method for reducing wear in moving parts and would not provide motivation to combine Lambert with the other references. It is noted that the method recited in claims 20-21 and 23 comprises only the step of contacting moving parts with the lubricant; in the passages cited in the previous office actions, Lambert clearly teaches and provides motivation for doing so, and further teaches that lubricants help prevent scuffing, which is a type of wear.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Goloboy whose telephone number is (571)272-2476. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JCG

/Glenn A Caldarola/
Acting SPE of Art Unit 1797